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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,667	01/19/2000	Stephen Donovan	D-2875	6119

7590 10/24/2005
Frank J Uxa
4 Venture Suite 300
Irvine, CA 92618

EXAMINER

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
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1656

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20051015

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

All claims are allowable. However, it appears claims 69-80 of the application (09/489,667) potentially interfere with at least claim 5 of U. S. Patent 6, 632,440 because both sets of claims encompass a modified clostridial neurotoxin comprising a clostridial neurotoxin without a functional Hc domain, covalently coupled to substance P. Claims 69-80 of the application are directed to an agent for treating pain comprising a modified clostridial neurotoxin, wherein modified clostridial neurotoxin is obtained by removing or modifying an Hc domain of a native clostridial neurotoxin to form an intermediate clostridial neurotoxin and covalently coupling substance P to the intermediate clostridial neurotoxin so that the modified clostridial neurotoxin no longer binds to neurotoxin receptors at a neuromuscular junction with the same affinity as the native clostridial neurotoxin; and claim 5 of the patent is directed to a compound that inhibits mucus secretion by mucus secreting cells, the compound comprising (a) a light chain (L-chain) or L-chain fragment of a clostridial neurotoxin, which comprises the active proteolytic enzyme domain of L-chain; (b) a target domain such as substance P that selectively binds to a target cell that is a mucus secreting cell; and (c) a translocating domain of a clostridial neurotoxin that translocates the L-chain or L-chain fragment into target cell; with the proviso that the compound is not a botulinum toxin. Thus, it appears claims 69-80 of the application would anticipate claim 5 of the patent, and claim 5 of the patent would anticipate claims 69-80 of the application. For response, please see attached "INTERFERENCE" sheet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Patent Examiner

CMK

CMK
October 18, 2005

Kathleen M. Kerr
KATHLEEN M. KERR, PH.D.
SUPERVISORY PATENT EXAMINER

INTERFERENCE

At least claim(s) 69-80 of the application are believed to interfere (35 U.S.C. § 135(a)) with at least claim(s) 5 of U.S. Patent 6,632,440. The patent claims priority of U.S. (or foreign identified by country) application United Kingdom 9818548.1 and appears to be entitled to benefit for the purpose of a priority contest under 35 U.S.C. § 135(a).

The patent is not prior art under 35 U.S.C. § 102(e). See, e.g., In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). Nevertheless, a patent cannot be issued to applicant until it prevails in an interference with the patent. In any interference, applicant would be the junior party.

Accordingly, applicant is required to make a showing under 37 CFR § 41.202(d) (see Notice of Final Rule, 69 Fed. Reg. 49960, 50019 (Aug. 12, 2004)) as to why it would prevail in an interference with the patent. Pursuant to 37 CFR 41.202(c), applicant must also comply with the requirements set forth in 37 CFR 41.202(a)(2)-(a)(6).

Note that "New evidence in support of priority will not be admitted except on a showing of good cause." 37 CFR § 41.202(d)(2); Hahn v. Wong, 892 F.2d 1028, 13 USPQ 1313 (Fed. Cir. 1989); Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed. Cir. 1992). Hence, applicant should not expect to make a showing in the first instance after the application is forwarded to the board for a determination of whether an interference should be declared.

A shortened statutory period for reply to this communication is set to expire THREE MONTHS from the mailing date of this action. Extensions of time may be granted under 37 CFR 1.136(a). **In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this communication.**

If a showing is timely presented, it will be forwarded to the board where it will be evaluated pursuant to 37 CFR § 41.202(e). If at the end of the six-month period, a showing is not timely presented, the application will be forwarded to the board where it would be expected that an order to show cause would be issued pursuant to 37 CFR § 41.202(d)(2).